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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/125,700 10/23/98 FUHRMANN

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EXAMINER

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PERMAN & GREEN
425 POST ROAD
FAIRFIELD CT 06430-6232

CHIANG, J
ART UNIT PAPER NUMBER

2642
DATE MAILED:

07/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/125700

Applicant(s)

Fuhrmann ET AL.

Examiner

J. Huang

Group Art Unit

2642

#10

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6-4-01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-9, 11-13, 15-24 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-9, 11-13, 15-24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

CLAIMS

Double Patenting Rejection

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9, 11-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over all claims of U.S. Patent No. (none, Serial No. 08/800591) ⁶³⁴⁷²¹⁸ in view of Kobayashi et al. (US 5722055).

According to the remarks filed on 06-04-2001, 08/800591 shows all the present claimed features except the loose keypad (see page 9 of the amendment filed on 06-04-2001). However, Kobayashi teaches providing a loose keypad (24). Hence, it would have been obvious for one skilled in the art to modify 591's by providing a loose keypad with/without the teaching of Kobayashi, this is simply a conventional way to position the keypad, especially in the phone environment.

112-First Paragraph Rejection

3. Claims 17-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See comments below.

4. Claims 17 - 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In claim 17, it claims "attachment means for attaching or detaching the second housing from the first housing by a user without employing a tool". In claim 21, it also claims "without employing a tool". This is questionable. In the original disclosure, page 7, it states to use "a pointed object", in page 10, it states "the front housing is mated to the rear housing and the two are screwed together with screws 43". It is not seen that it is not using "a tool". Therefore, the claim is considered unenabling and a new matter.

Further, in claim 18, paragraphs 1-4 describe "a housing" and "a detachable external wall", it appears to describe figs. 1-4. In the last paragraph of claim 18, it describes the position of the key unit, that appears to be fig. 5. They are two different embodiments. The original disclosure does not support to have the housing and the detachable wall shown in figs. 1-4 and yet to have the position of the key unit shown in fig. 5 (note: the key unit in figs. 1-4 is not free to move when the external wall 14 is released).

Claims 19-21 have a similar problem as claim 18. Therefore, claims 18-21 are considered unenabling and a new matter.

Art Rejection

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-9, 11-12, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (US 5722055).

Regarding claim 1, Kobayashi shows:

A first housing (23);

A second housing (25);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (ie 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claim 15, Kobayashi shows:

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A back housing (23);

At least one key unit (24);

At least one key sensor (41, 42);

A front housing (25);

At least one opening (see 25-1-7-1);

Retaining means (22) comprising a cover (ie 43) for holding the electronic components (in 22) to the back housing (23, see 54 in fig. 33) when the front housing (25) is released from the first housing (23);

the key unit (24) is held between the front and back housings (25, 23), and is free to move when the front housing (25) is released (see 50-51).

Regarding claim 16, Kobayashi shows:

A first housing (23);

A second housing (25);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (ie 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is sandwiched between the front and back housings (25, 23), and is free to move when the second housing (25) is released (see 50-51).

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Regarding claim 17, as best understood, Kobayashi shows:

A first housing (23);

A second housing (25);

Attachment means (50-51);

At least one key unit (24);

At least one key sensor (41, 42);

Retaining means (22) comprising a cover (ie 43) for holding the electronic components (in 22) to the first housing (23, see 54 in fig. 33) when the second housing (25) is released from the first housing (23), the key unit (24) is free to move when the second housing (25) is released (see 50-51).

Regarding claims 2-9, 11-12, Kobayashi shows:

The user interface second housing (25);

A circuit board (ie 41, 45);

The key sensor (see 41);

The cover, the components and the circuit board (43, 41, 45);

The releasable cover (see 43, 43-4);

The cover aperture (see 43);

A sealing member (ie 40);

the first housing (23);

the second housing (25);

the key unit which is a key mat (24); and

the key sensor (41, 42).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al. In view of Takagi et al. (US 523566).

Regarding claim 13, Kobayashi shows the key sensor (41, 42).

Kobayashi differs from the claimed invention in that it does not explicitly mention that the key sensor is a membrane type of key switch.

However, membrane type of key switch is one of the most common type of key switch, this is shown by Takagi (see 10). Hence, if it is found that Kobayashi is not the membrane type of switch, then it would have been obvious for one of ordinary skill in the art to use the membrane type of switch in Kobayashi with/without the teaching of Takagi, because it is a conventional type of switch.

9. Claims 18-24 are too questionable to evaluate, therefore, no art rejection is applied.

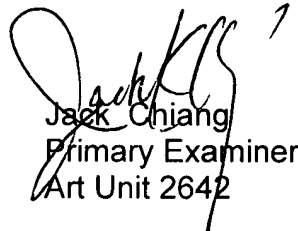
ARGUMENT

10. In response to the remarks, pages 9-11, Tomura is withdrawn, therefore, no further discussion is made in regard to Tormura. Argument is answered by the new rejection above, see comments above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Admad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.


Jack Chiang
Primary Examiner
Art Unit 2642